

REMARKS

Reconsideration of this application is respectfully requested.

Claims 1-16 are in the application. Claims 1 and 13 have been amended. Claim 13 has been amended to correct a typographical error.

I. REJECTION UNDER 35 U.S.C. §102(e) OVER FRANK et al.

In the Official Action, the Examiner rejected claims 1-16 as being allegedly anticipated by Frank et al. (U.S. Published Patent Appl. No. 2006/0224412 A1).

Frank et al. is directed to a system and method for selecting and protecting intellectual property assets. In formulating the rejection, the Examiner relied on the product search set forth in paras. [0311] – [0315]. For the step of “searching, executed without the user’s involvement, said second database” as set forth in claim 1, the Examiner relied specifically on para. [0314] and Figures 82 and 83. Para. [0314] describes the use of a product search results GUI component. As stated at para. [0314], “FIGS. 82-83 show a view product GUI component that displays a more detailed view of *a product data record.*” With a product search, product data records are identified. (See para. [0314], “The product search results GUI component can display the product data records that met the criteria as specified by a user via the search products GUI component illustrated in FIGS. 78-80.”). Further as set forth at para. [0314], “[t]he view product GUI component as illustrated in FIGS. 82-83 can cause the display of *data fields of the product data sheet* such as; the product number...”. As set forth at paras. [0297] – [0310], the data fields

are pre-associated with the respective product data sheets. In other words, the identification of the product data sheet automatically results in identification of the related data fields. There is no additional search after the product data records are identified.

Amended claim 1 is directed to a method for investigating intellectual property related to a reference piece of intellectual property including the steps of: "providing a first database of discrete pieces of first intellectual property, said pieces of first intellectual property each including an associated set of first characteristics"; "providing a second database of discrete pieces of second intellectual property, said second intellectual property being of a different type from said first intellectual property, said pieces of second intellectual property being initially unassociated with said pieces of first intellectual property"; searching the first database to identify pieces of first intellectual property having predetermined characteristics in common with the reference piece of intellectual property; "developing, executed without the user's involvement, at least one query based on at least a portion of said first characteristics of said identified pieces of first intellectual property"; "searching, executed without the user's involvement, said second database to identify said pieces of second intellectual property satisfying said at least one query"; and "transmitting information related to said identified pieces of second intellectual property to the user."

Frank et al. does not disclose or suggest the invention of claim 1. In particular, based on the Examiner's reasoning in the Office Action, the first database in Frank et al. is the product search database, and the second database is one or more of the related data fields associated with

the uncovered product data sheets. As set forth in amended claim 1, "pieces of second intellectual property" are "initially unassociated with said pieces of first intellectual property". Frank et al. fails to disclose or suggest that the data fields are initially unassociated with the product data sheets. Frank et al. has an initial association with the data field information being part of the product data sheets. It is respectfully submitted that claims 1-16 are patentable over Frank et al.

II. REJECTION UNDER 35 U.S.C. §102(e) OVER LEE

The Examiner rejected claims 1-16 under 35 U.S.C. §102(e) as being allegedly anticipated by Lee (U.S. Patent No. 6,694,331). In response to Applicant's previous arguments, the Examiner relied on passages at col. 11, ll. 37-39 and col. 12, ll. 19-29 in Lee. The Examiner specifically stated,

The [Lee] disclosure differentiates between automatically generating, adding, or suggesting a field-of-search. Clearly, "suggesting" a field-of-search would require user interaction to confirm or modify the suggestion. However, the reference also discloses, separately from suggesting a field-of-search, generating or adding a field-of-search. Since this is differentiated from the disclosed "suggesting" a field-of-search, there is a clear suggestion that the "generated" or "added" field-of-search is not presented to the user to await some user action.

Furthermore, it is also disclosed that "...the field-of-search thus created can form (or be a part of) a search query or criteria to be executed by a local or remote database." This disclosure also clearly suggests that the field-of-search is automatically generated and thereafter executed without user interaction.

The Examiner's assertions are respectfully traversed.

In contrast to the method of claim 1, Lee does not disclose or suggest a method which conducts a first search and then executes at least one query for a second search without user involvement, with the uncovered results being transmitted to the same user. Lee is concerned with conducting searches to identify potentially relevant intellectual property. See, e.g., col. 1, ll. 50-55. Lee relies on user involvement to determine the search criteria in establishing relevancy. With the subject invention, a search is conducted to identify possibly relevant intellectual property by inputting only once characteristics of a reference piece of intellectual property. Without user involvement, the subject invention entails a search of a first database to generate at least one query for the search of a second database. Lee requires user involvement to conduct additional searching.

In the Official Action, the Examiner asserted that Lee discloses automatic development and execution of a query at col. 11, ll. 37-39, and at col. 12, ll. 19-29. However, the cited excerpts refer to generating query information for review by a user for later searching. Specifically, the cited excerpts refer to the Field-of-Search Module 314. As stated at col. 11, ll. 17-21,

A user presented with a list of such information (or other useable output) from **Field-of-Search Module 314** may use the list as an aid in determining, preparing, formulating, or otherwise creating **a field-of-search** (or any other practical use).

The created “field-of-search” is provided to the user for review.

The passage at col. 11, ll. 37-39 relied upon by the Examiner states: “Field-of-Search Module 314 may automatically (or manually) create, add, or suggest such search information

(e.g., classes and subclasses) for a field-of-search.” This passage refers to the processing conducted by the Field-of-Search Module 314 in preparing a field-of-search. As discussed below, however produced, the resulting field-of-search will be provided to the user prior to execution. Thus, whether portions of the field-of-search are suggested or automatically generated, the field-of-search is still reviewed by a user before use.

With reference to col. 11, l. 63 – col. 12, l. 29, a method of creating a field-of-search by the Field-of-Search Module 314 is set forth. Step 708 of the method is described as: “The search information may be displayed or otherwise output for viewing by the user to assist in the creation of a field-of-search”. Figure 5 calls Step 708: “CREATE FIELD-OF-SEARCH”. As shown in Figure 5, Step 709 may be optionally added which adds information to the information delivered to the user in Step 708. Step 709 is described at col. 12, 19 – 26 and includes the notion of “automatically generating, adding, or suggesting a field-of-search” (col. 12, ll. 19-22). It is clear that from a reading of Lee and Figure 5, the field-of-search generated by the Field-of-Search Module 314 (however generated thereby) is delivered to the user for review in creating a field-of-search.

The Examiner relied on the statement at col. 12, ll. 26-29 in asserting that automatic execution of the field-of-search is disclosed after generation of the field-of-search. The passage states: “As used in a search system, as one example, *the field-of-search thus created* can form (or be part of) a search query or criteria to be executed by a local or remote database.” This passage follows a description of Steps 708 and 709 discussed above. It is clear that a field-of-

search created by that method is referred to in the passage — i.e., a field-of-search that involves user review prior to execution. Once a field-of-search is created by a user, the user can utilize a local or remote database to execute it in accordance with col. 12, ll. 26-29. Claim 1 requires developing a query and executing the query without user involvement. Lee requires user involvement. It is respectfully submitted that claims 1-16 are patentable over Lee.

III. CONCLUSION

Favorable action is earnestly solicited. If there are any questions or if additional information is required, the Examiner is respectfully requested to contact Applicant at the number listed below.

Respectfully submitted,

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